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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/365,426	08/02/1999	PETER HARTMAIER	51410-P013US	1765

29053 7590 06/05/2003

DALLAS OFFICE OF FULBRIGHT & JAWORSKI L.L.P.
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EXAMINER

FELTEN, DANIEL S

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 06/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/365,426

Applicant(s)

Hartmaier

Examiner

Folten

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 9/30/2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-15, 23, 27-32, 34-40 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 15, 23 and 34-40 is/are allowed.
- 6) ☒ Claim(s) 11-14, 27 and 28 is/are rejected.
- 7) ☒ Claim(s) 29-32 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other: _____

DETAILED ACTION

- 1
- 2 1. Receipt of the amendment filed September 2002 amending claim 11 and canceling claim
- 3 33 is acknowledged. Claims
- 4
- 5

Response to Arguments

- 6
- 7 2. Applicant's arguments with respect to claims 11-14, 27 and 28 have been considered
- 8 but are moot in view of the new ground(s) of rejection.
- 9
- 10

Claim Rejections - 35 USC § 103

- 11
- 12 3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all
- 13 obviousness rejections set forth in this Office action:

14 (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth

15 in section 102 of this title, if the differences between the subject matter sought to be patented and the prior

16 art are such that the subject matter as a whole would have been obvious at the time the invention was

17 made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall

18 not be negated by the manner in which the invention was made.

19

1 4. Claims 11-14, 27 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable
2 over Taskett (WO 97/04579, hereinafter "T579" and WO25237, hereinafter "T237") in view
3 of Kawan (US 5,796,832) and Pitroda (US 5,590,038).

4
5
6 **Regarding claims 11-14, 27 and 28 :**

7 T237 discloses a method of providing prepaid account services to consumers
8 comprising the steps of:

9 assigning prepaid accounts to said consumers (see T237, *issuing a transaction card with*
10 *an a unique authorization account code* 142-- see fig 2, Abstract and page 7, line 17 to at least
11 page 8, line 2);

12 communicating with a service provider network/host computer regarding consumer
13 replenishment transactions (see T237, fig. 6, block 620--*recharge account* and block 610--
14 *prompt selection from menu*, also at least page 15, lines 5-6) .

15 wherein said communicating with the network step further comprises the steps of:

16 receiving transaction messages following individual replenishment transactions by said
17 consumers; and sending a message indicating the disbursement of funds associated with said
18 replenishment transactions(610--*prompt selection from menu*---*next appropriate action*...
19 indicates that the replenishment transaction has been made, also at least page 15, lines 5-6);

1 communicating with a prepaid engine regarding said consumer replenishment
2 transactions (see T237, fig. 7, Block 710--prompt caller to recharge account).

3 T237 fails to disclose receiving a reconciliation message summarizing individual
4 transactions that occurred during a certain period, and reconciling said individual transactions.
5 This feature is disclosed in T579 (see T579, at least page 4, lines 9-12 and lines 19-23). In
6 view of the teaching of T579 it would have been obvious for an artisan of ordinary skill in the
7 art at the time of the invention to employ the notoriously old and well known method of
8 generating and transmitting summary transaction data, as taught by T579 into the T237 system,
9 because it would have been an obvious extension to the T237 teaching of checking the account
10 balance of an calling card/transaction card, and/or regenerating a calling card/phone card
11 account from the user menu options. The transaction summary data would provide the
12 consumer with an obvious alternative method of checking the account balance or regeneration
13 transaction by visually reviewing any kind of transaction data/history stored by the host
14 computer/service provider network. Thus such a modification would be an obvious expedient
15 to one of ordinary skill in the art.

16 T237 also fails to disclose, as in claims 11, 13 and 14, communicating with a service
17 banking network/host computer regarding consumer replenishment transactions. T579 teaches
18 an Automated Teller Machine as a device in which to use the prepaid instrument/prepaid
19 transaction card (see page 6, line 1 +). Since ATMs are conventionally associated with a
20 banking/financial network, it would have been obvious for an artisan of ordinary skill at the

1 time of the invention of T237 to substitute the ATM/financial network of T579 for the Service
2 provider network of T237 because an artisan at the time of the invention would recognize that
3 the ATM/financial network would be a alternative source for financial data retrieval and
4 replenishment, being an art recognized equivalent to the T237 service provider network,
5 inasmuch as financial data can be stored and retrieved from both devices. Thus such a
6 modification would have been an obvious matter of design choice to one of ordinary skill in the
7 art.

8 T237 also fails to disclose associating said prepaid accounts with wireless telephones.
9 This feature is found in Kawan (see figs. 2C and fig. 4, col. 4, lines 4-14; and col. 6, lines
10 4+). Since both T237 and T579 are associated with prepaid phone card accounts, it would
11 have been obvious for an artisan of ordinary skill at the time of the inventions to T237 and
12 T579 to substitute the association of the wireless prepaid phone card account for the normal
13 phone card account such a modification/substitution would be considered one of art
14 recognized equivalence and thus an obvious expedient to one of ordinary skill in the art.

15 T237 also fails to disclose sending a disbursement message to the banking network,
16 wherein the disbursement message network regarding the distribution of funds associated with
17 the replenishment transactions. Pitroda discloses a universal electronic transaction card which
18 may transmit transaction information over financial and other networks (see Pitroda, col. 7, ll.
19 10 to col. 8, ll. 17; and col. 10, ll. 53+). Since both T237 and T579 are associated with
20 prepaid phone card accounts, it would have been obvious for an artisan of ordinary skill at the

1 time of the inventions to T237 and T579 to substitute the UET card for the normal phone card
2 because an artisan at the time of the invention would have recognized the convenience and
3 versatility of the UET to provide the user with various transaction means in one. Thus a user
4 to would have sought to use such a card in the system as T237, having the ability to perform a
5 diversity of relating functions. Thus such a substitution would be an obvious expedient well
6 within the ordinary skill in the art.

7
8 ***Conclusion***
9

10 5. Any inquiry concerning this communication or earlier communications from the examiner
11 should be directed to ***Daniel S. Felten*** whose telephone number is (703) 305-0724. The
12 examiner can normally be reached between the hours of 7:00AM to 5:30PM Monday-Thursday.
13 Any inquiry of a general nature relating to the status of this application or its proceedings should
14 be directed to the Customer Service Office (703) 306-5631, or the examiner's supervisor
15 ***Vincent Millin*** whose telephone number is (703) 308-1065.
16

17 6. Response to this action should be mailed to:
18

19 Commissioner of Patents and Trademarks

20 Washington, D.C. 20231
21

22 for formal communications intended for entry, or (703) 305-0040, for informal or draft
23 communications, please label "Proposed" or "Draft".

1 Communications via Internet e-mail regarding this application, other than those under 35
2 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be
3 addressed to *[daniel.felten@uspto.gov]*.

4 All Internet e-mail communications will be made of record in the application file. PTO
5 employees do not engage in Internet communications where there exists a possibility that
6 sensitive information could be identified or exchanged unless the record includes a properly
7 signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly
8 set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and
9 Trademark on February 25, 1997 at 1 195 OG 89.

10
11 

12
13 **DSF**

14 **May 31, 2003**


HANI M. KAZIMI
PRIMARY EXAMINER